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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,143	02/28/2002	David Engel	87335.3461	5066

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EXAMINER

THOMPSON, KENNETH L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/084,143

Applicant(s)

ENGEL, DAVID

Examiner

Kenn Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kocsuta, U.S. 2,950,132.

Regarding claim 1, Kocsuta discloses in figures 1-9 a retaining ring (6) movable between an unyielded and yielded state. Kocsuta discloses a generally C-shaped region (fig 3) having an inner peripheral surface and an outer peripheral surface. Kocsuta discloses a first end (left 22) and a second end (right 22). Kocsuta discloses the retaining ring is formed from a yieldable material that yields when moved from the unyielded state to the yielded state (col. 2, lines 27-37).

As to claims 2 and 3, Kocsuta discloses a first leg (left 22a, 23) extending from the first end and a second leg (right , 22a, 23) extending from the second leg.

As to claim 4, Kocsuta discloses the C-shaped portion is circular in shape.

As to claim 5, Kocsuta discloses the legs having a respective termination portion (22,23).

As to claim 6, Kocsuta discloses the termination portion of the first and second leg have a tool receiving region (23).

As to claim 7, Kocsuta discloses the tool receiving region is a hole (fig 3).

As to claims 8, 9, 15, 16, 19 and 20, Kocsuta discloses the ring is constructed from ductile material and is non-hardened stainless steel. Applicant should note that the selection of

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a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As to claims 10 and 11, Kocsuta discloses four fingers projecting from the inner peripheral surface (fig 8).

As to claim 12, Kocsuta discloses the first and second legs are substantially straight and point toward each other in the unyielded state (fig 8, faces 22).

As to claim 13, Kocsuta discloses the C-shaped region is an arc that encompasses 270 degrees (fig 3).

As to claim 14 and 17, Kocsuta discloses twisting the retaining ring in a first direction using a tool, reducing the diameter of the ring and causing the ring to yield into a yielded state (col. 2, lines 3-7). Kocsuta discloses twisting the retaining ring in a second opposite direction to the first direction using the tool, increasing the diameter of the ring and causing the ring to yield into an unyielded state (col. 2, lines 30-37).

As to claim 18, Kocsuta discloses moving the ring from a first unyielded state to a second yielded state by rotating a tool engaged with opposed legs of the ring (col. 2, lines 3-7). Kocsuta discloses aligning the ring with a groove (11) in the housing (3). Kocsuta discloses moving the ring from the second yielded state into the first unyielded state by rotating the tool engaged with the legs of the ring (col. 2, lines 30-37). Kocsuta discloses moving the ring from the first state to the second state causes the ring to yield and the moving the ring from second state to the first state also causes the material to yield.

As to claim 21, Kocsuta discloses a generally C-shaped region having an inner peripheral surface ((fig 3, 6 at 20), an outer peripheral surface (28), a first leg (left 22, 22a, 23) and a second leg (right 22,22a,23). Kocsuta discloses the retaining ring being formed from a yieldable material that yields when moved from the unyielded state to the yielded state. Kocsuta discloses

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the first land second leg extending from the first and second end and having a first and second tool receiving means (23) for receiving a tool.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a twist ring having little or no memory shape) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the prior art of Kocsuta does not disclose "the retaining ring is formed of a yieldable material that yields when moved from the unyielded state to the yielded state". However given its broadest reasonable interpretation, the limitation requires a ring capable of being deformed, which is an inherent capability of the resilient ring disclosed by Kocsuta. Applicant is reminded that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Timmer, U.S. 4,151,779 and Field, U.S. 1,689,087 disclose a similar retaining ring.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

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mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703 308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-2168.

KT
September 4, 2003


Lynne H. Browne
Supervisory Patent Examiner
Group 3600